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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/775,599	02/05/2001	Joseph G. Gatto	23449-016	9235

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EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT PAPER NUMBER

3624

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/775,599

Applicant(s)

GATTO, JOSEPH G.

Examiner

Narayanswamy Subramanian

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23, 38, 39 and 51 is/are rejected.
- 7) ☒ Claim(s) 24-37, 40-50 and 52-54 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5/2/01, 6/29/01, 2/14/03
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Original claims 1-54 have been examined. The objections and rejections are stated below.

#### ***Drawings***

2. This application has been filed with informal drawings, which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

#### ***Specification***

3. Applicant is reminded of the proper language and format for an abstract of the disclosure. The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The abstract provided exceeds 150 words. Correction is required.

#### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".
5. Claims 1, 3-38 and 40-54 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, *or* composition of matter, *or* any new and useful improvement thereof" (emphasis added).

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Claims 1, 3-38 and 40-54 are rejected under 35 U.S.C. § 101 because; the claimed invention is directed to a non-statutory subject matter. Specifically the method claims as presented do not claim a technological basis in the pre-amble and the body of the claim. Without a claimed basis, the claim may be interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore non-statutory under 35 U.S.C. 101. In contrast, a method claim that includes in the body of the claim structural / functional interrelationship which can only be computer implemented is considered to have a technological basis [See Ex parte Bowman, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) - used only for content and reasoning since not precedential].

In order to over come the 101 rejection above, the following preamble is suggested:

"A computer implemented method for displaying information ---", or something similar. Also, in the body of the claim include structural / functional interrelationship which can only be computer implemented.

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1, 2, 38 and 51 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 3 and 26 of U.S. Patent No. 09/524,253. Although the conflicting claims are not identical, they are not patentably distinct from each other because they recite the means or steps that are substantially the same and that would have been obvious to one of ordinary skill in the art.

Claims 1, 2, 38 and 51 recite essentially the steps and means that are listed in claims 1, 2, 3 and 26 of Gatto ('253). The phrases "earnings event" is replaced by "future event" and "earnings estimate" is replaced by "estimate". The error metric is the selected criteria. These changes do not add any further limitations to the ones cited in '253 of Gatto.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-23, 38, 39 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall (US Patent 6,073,115) in view of Lundgren (US Patent 5,608,620).

With reference to claims 1 and 38, Marshall discloses methods for displaying information relating to financial data displaying simultaneously the financial data in a format selected by the user (See Marshall Abstract, Col 3 lines 41-48, Claim 1)

Marshall does not explicitly disclose the step wherein the information relates to one or more analysts' estimates for a selected future event an analyst by analyst basis, for selected analysts, an indication of historical accuracy for that analyst based on selected criteria and the analyst's estimate or recommendation for a future event.

Lundgren discloses the step wherein the information relates to one or more analysts' estimates for a selected future event an analyst by analyst basis, for selected analysts, an indication of historical accuracy for that analyst based on selected criteria and the analyst's estimate or recommendation for a future event (See Lundgren Abstract, Figure 1, Col 1 lines 21-50, Claim 1).

Both Marshall and Lundgren are concerned with aiding an investor with his/her decision-making. It would have been obvious to one with ordinary skill in the art at the time of the current invention to combine the steps taught by Lundgren to the invention of Marshall. The combination of the disclosures taken as a whole suggests that users would

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have benefited from being able to view data about analysts' forecasts in a format they are comfortable with and helped them in their decision making.

With reference to claims 2, 39 and 51, Marshall discloses a system and method for displaying information relating to financial data displaying simultaneously the financial data in a format selected by the user (See Marshall Abstract, Col 3 lines 41-48, Claim 1). The system includes a database (See Marshall Col 8 lines 47-53) and means for displaying information simultaneously.

Marshall does not explicitly disclose the step wherein the information relates to one or more analysts' estimates or recommendation for a selected future event an analyst by analyst basis, for selected analysts, an indication of historical accuracy for that analyst based on selected criteria and actual results and the analyst's estimate for a future event.

Lundgren discloses the step wherein the information relates to one or more analysts' estimates for a selected future event an analyst by analyst basis, for selected analysts, an indication of historical accuracy for that analyst based on selected criteria and actual results and the analyst's estimate or recommendation for a future event (See Lundgren Abstract, Figure 1, Col 1 lines 21-50, Claims 1, 6, 8-11).

Both Marshall and Lundgren are concerned with aiding an investor with his/her decision-making. It would have been obvious to one with ordinary skill in the art at the time of the current invention to combine the steps taught by Lundgren to the invention of Marshall. The combination of the disclosures taken as a whole suggests that users would have benefited from being able to view data about analysts' forecasts in a format they are comfortable with and helped them in their decision making.

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With reference to claims 3-23, the features in these claims are old and well known in the art. It would have been obvious to include these features to the combined disclosures of Marshall and Lundgren. The combination of the disclosures taken as a whole suggests that users would have benefited from being able to view time series data about analysts' forecasts in their preferred format and helped them in their decision making.

***Allowable Subject Matter***

10. Claims 24-37, 40-50 and 52-54 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (703) 305-4878. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065. The fax number for Formal or Official faxes and Draft to the Patent Office is (703) 872-9306.

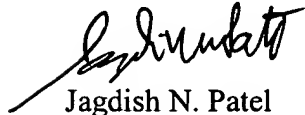
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you



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have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

N. Subramanian  
March 18, 2005



Jagdish N. Patel  
Primary Examiner